



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,498	02/22/2002	Robert Fransdonk	5782P007	3732

21186 7590 01/13/2006

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH
1600 TCF TOWER
121 SOUTH EIGHT STREET
MINNEAPOLIS, MN 55402

EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,498

Applicant(s)

FRANSDONK, ROBERT

Examiner

John M. Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-45 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/14/2005, 5/20/2002

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 3621

DETAILED ACTION

STATUS

Claims 1-45 are pending.

Response to Arguments

The Applicant's arguments filed on October 28, 2005 have been fully considered.

The indicated allowability of claims 14, 15, 29, 30 44 and 45 has been withdrawn in view of the newly discovered reference to Colosso (US Patent 6,169,976). Rejections based on the newly cited reference follows. The Examiner apologized for the delay in the discovery of this new art.

The Examiner responds that in response to applicant's argument that there is no prima facie case of obviousness, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the cited references deal with the subject of licensing media.

The Examiner submits that the newly discovered reference to Colosso (US Patent 6,169,976) discloses the claimed features of a signature field containing a client identifier and a product key.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al (US Patent 5,499,298) in view of Colosso (US Patent 6,169,976)

As per claim 1,

Narasimhalu et al. ('298) discloses

Transmitting a license from a server to a secure device for storage, (Figure 2, Column 5, lines 35-50 [the header of the COIN structure contains a signature field equivalent to a client identifier])

Art Unit: 3621

Transmitting via electronic network an entitlement control message containing content keys associated with said watercrypted content to said secure device (Column 6, lines 46-50; Figure 3)

Receiving said session content key from said secure device in response to said request together with a request to provide a session content key from content key, said session content key to be used to decrypt said watercrypted content (Column 7, lines 61-67; column 8 lines 1-23)

Narasimhalu et al. ('298) does not explicitly disclose the license containing a product key of watercrypted content and a client identifier. Colosso ('976) discloses the license containing a product key of watercrypted content and a client identifier (Column 15, lines 1-18) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Narasimhalu et al. ('298) method with the Colosso ('976)'s method in order to prevent piracy of the media.

Narasimhalu et al. ('298) discloses the claimed invention except for "plurality of content keys", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of content keys, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 16, 31 and 33 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2,
Narasimhalu et al. ('298) discloses the method according to claim 1,
wherein said license is encrypted with a public key of said secure device to allow said secure device to access said license (Column 6, lines 1-14)

Claims 17 and 34 are in parallel with claim 2 and are rejected for at least the same reasons.

As per claim 3,
The method according to claim 1, wherein said license is encrypted with a secret key of said secure device to allow said secure device to access said license (Column 6, lines 1-14)

Claims 18 and 35 are in parallel with claim 3 and are rejected for at least the same reasons.

As per claim 4,
Narasimhalu et al. ('298) discloses the method according to claim 1,
further comprising establishing a secure channel to communicate securely with secure device (Figure 3, Column 7, lines 4-10)

Claims 19 and 36 are in parallel with claim 4 and are rejected for at least the same reasons.

Art Unit: 3621

As per claim 5

Narasimhalu et al. ('298) discloses the method according to claim 4, wherein said establishing further comprises:

encrypting a transport key with a personal public key, transmitting said transport key to said secure device (Column 6, lines 1-14)

Claim 20 and 37 are in parallel with claim 5 and are rejected for at least the same reasons.

As per claim 6

Narasimhalu et al. ('298) discloses the method according to claim 4, wherein said receiving further comprises:

Receiving said session content key encrypted with said transport key, decrypting said session content key to be used in decrypting said waterencrypted content (Column 6, lines 1-14).

Claims 21 and 38 are in parallel with claim 6 and are rejected for at least the same reasons.

As per claim 7

Narasimhalu et al. ('298) discloses the method according to claim 1 wherein said secure device is a smart card device (Column 6, lines 66-67; column 7 lines 1-10)

Claims 22 and 39 are in parallel with claim 7 and are rejected for at least the same reasons.

As per claim 8

Narasimhalu et al. ('298) discloses the method according to claim 1 further comprising:

Receiving said license from a content server which distributed said waterencrypted content (Column 6, lines 1-14)

Claims 23 and 40 are in parallel with claim 8 and are rejected for at least the same reasons.

As per claim 9

Narasimhalu et al. ('298) discloses the method according to claim 1 further comprising:

Receiving said license from a content server which distributed said waterencrypted content, said entity storing a client identifier and being configured to encrypt said product key with a public key of said secure device (Column 6, lines 1-14)

Claims 24 and 41 are in parallel with claim 9 and are rejected for at least the same reasons.

As per claim 10

Narasimhalu et al. ('298) discloses the method according to claim 1 further comprising:

Art Unit: 3621

Receiving said entitlement control message from a content server which distributed said waterencrypted material (Column 6, lines 1-14)

Claims 25 and 42 are in parallel with claim 10 and are rejected for at least the same reasons.

As per claim 11,

Narasimhalu et al. ('298) discloses

Electronically storing a license containing a product key of a waterencrypted content and a client identifier from a decoder. (Figure 2, Column 5, lines 35-50 [the header of the COIN structure contains a signature field equivalent to a client identifier])

Receiving via electronic network an entitlement control message containing content keys associated with said waterencrypted content from said decoder (Column 6, lines 46-50; Figure 3)

together with a request to provide a session content key from content key, said session content key to be used to decrypt said waterencrypted content, selecting said session content key using said product key and said client identifier from said license. (Column 7, lines 61-67; column 8 lines 1-23)

transmitting Receiving said session content key from said secure device in response to said request.

Narasimhalu et al. ('298) discloses the claimed invention except for "plurality of content keys ", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of content keys, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 16 , 31 and 33 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 12

Narasimhalu et al. ('298) discloses the method according to claim 11 wherein said license is encrypted with a personal public key to allow access to said license (Column 6, lines 1-14)

Claims 27 and 43 are in parallel with claim 12 and are rejected for at least the same reasons.

As per claim 13

Narasimhalu et al. ('298) discloses the method according to claim 11 wherein said license is encrypted with a personal public key to allow access to said license (Column 6, lines 1-14)

Claim 28 is in parallel with claim 12 and is rejected for at least the same reasons.

As per claim 14

Narasimhalu et al. ('298) discloses the method according to claim 11

Art Unit: 3621

Narasimhalu et al. ('298) does not explicitly disclose receiving a transport key encrypted with a public key of said decoder; and encrypting said session key with said transport key Colosso ('976) discloses receiving a transport key encrypted with a public key of said decoder; and encrypting said session key with said transport key (Column 15, lines 28-60; figure 3 – the combination of the installation key and the domain name constitute the transport key) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Narasimhalu et al. ('298) method with the Colosso ('976)'s method in order to prevent piracy of the media.

Claims 29 and 44 are in parallel with claim 14 and are rejected for at least the same reasons.

As per claim 15

Narasimhalu et al. ('298) discloses the method according to claim 11

Narasimhalu et al. ('298) does not explicitly disclose receiving a transport key encrypted with a public key of said decoder; and encrypting said session key with said transport key Colosso ('976) discloses receiving a transport key encrypted with a public key of said decoder; and encrypting said session key with said transport key (Column 15, lines 28-60; figure 3 – the combination of the installation key and the domain name constitute the transport key) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Narasimhalu et al. ('298) method with the Colosso ('976)'s method in order to prevent piracy of the media.

Claims 30 and 45 are in parallel with claim 15 and are rejected for at least the same reasons.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 3621

applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW

January 8, 2006

Nella Sime A.
PRIMARY EXAMINER